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09/504,236	02/15/2000	Swain W. Porter	112076-138321	7611

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ART UNIT	PAPER NUMBER
2141	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 November 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,12-20,24,26-29,31-38,41-46 and 48-71* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,12-20,24,26-29,31-38,41-46 and 48-71* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

Response to Amendments
Claims 1, 5, 28, 29, 45 and 56 have been amended.
Claims 7-11, 21-23, 25, 30, 39, 40 and 47 are cancelled.

Claims 1-6, 12-20, 24, 26-29, 31-38, 41-46 and 48-71 are pending.

Response to Arguments

I.   Applicant's arguments filed 11/27/2007 have been fully considered but they are not

persuasive.

A.   **Applicant argues that the prior art of record, *Pennell et al* (6,874,023), fail to teach
receiving email addresses from an email service provider as recite in claim 1.**

Examiner respectfully disagrees. *Pennell et al* clearly teaches that a user having

multiple email addresses is able to employ the email addresses for different communication uses

(*col.1 lines 53-62, col.3 lines 1-12 and 35-42*). It is inherent and obvious that the email addresses

have been provided by an email service provider.

B.   **Applicant argues that the prior art of record, *Pennell et al* (6,874,023) and *Winbladh*
(6,205,330), fail to teach the provision of separate and distinct email addresses in a
collection of email addresses.**

Examiner respectfully disagrees. *Pennell et al* clearly teaches that a user having

multiple unique email addresses is able to employ each unique email addresses for different

communication uses (*col.1 lines 53-62, col.3 lines 1-12 and 35-42, col.4 lines 15-17*). *Winbladh*

further teaches providing the user with a collection of email addresses, comprising a primary

address and an alias address (*col.4 lines 54-57, col.8 lines 46-50*). Furthermore, *Pennel et al*

teaches that the system allows the user to create unique email addresses used for communicating

with different web entities, wherein all messages from a particular web entity are sorted

according to the unique email address used by the web entity (*Figure 5, col.3 lines 13-20, 54-*

65), which supports that the unique email address is obviously "separate and distinct" since it is

able to be distinctly sorted and separated from other messages received from other

websites/communication partners addressed to other unique aliases/identifiers employed by the

user.

      C.   **Applicant argues that the prior art of record, *Beyda et al* (7,120,927), fail to teach receiving email addresses from an email service provider and providing notice back to the email service provider when the email address is used with particular communication partners.**

      Examiner respectfully disagrees. As discussed above in response to Arguments A

and B, *Pennell et al* with *Winbladh* clearly teach receiving email addresses from an email service

provider. *Beyda et al* was applied in combination with *Pennell et al* and *Winbladh* to teach the

claimed feature of claim 24: prior to the first communication partner or group of communication

partners initiating a communication with the user, notifying the email service provider of said

employment of the first email address to facilitate communication with the first communication

partner or group of communication partners and the electronic device, prior to the second

communication partner or group of communication partners initiating a communication with the

user, notifying the email service provider of said employment of the second email address to

facilitate communication with the second communication partner or group of communication

partners. *Beyda et al* teach that a use/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2144r notifies the relay server of the selected alias email address prior to using the alias email address (*col.5 lines 19-45, col.7 lines 21-63*). This teaching in combination with *Winbladh's* teaching for generating alias email addresses at the same time the primary email address is generated (*col.4 lines 54-57, col.8 lines 46-50*), makes obvious the notification of the use of the alias email address to the email service provider prior to a communication partner contacting the user using that particular email address, since the alias email address is registered at and generated by the email service provider.

D. **Applicant argues that the prior art of record, *Gabber et al* (6,591,291), fail to teach notification to the email service provider of the addresses of the websites with which the user is communicating.**

Examiner respectfully disagrees. *Gabber et al* teach the method of sending information to the email service provider relating the first email address to the first intended communication partner or partners and the second email address to the second intended communication partner or partners (*col.3 lines 35-41, col.8 lines 27-50*), by disclosing embodiments that relate the user's alias email address to the destination address used by the sender in order to determine what website is using the user's alias email address (*col.8 lines 5-18, col.8 line 62-col.9 line 25*). Notifying the email service provider of the addresses of the websites with which the user is communicating, is thus made obvious by the system's ability to relate the user's alias address to the destination address.

E. **Applicant argues that the prior art of record, *Gabber et al* (6,591,291), fail to teach sorting received emails based on intended versus unintended communication partners of an email address.**

Examiner respectfully disagrees. *Gabber et al* teach organizing and filtering of reply

emails based the alias source address, wherein the alias source address depends on the

destination address in order to identify which alias addresses are reject alias source addresses—if

the reply email contains a reject alias source address then the reply message is deleted (*Abstract,*

col.3 lines 20-44, col.8 lines 5-18 and 27-66). Furthermore, *Pennell et al* teaching of the unique

email addresses, the unique email addresses are able to be sorted according the unique identifier

of the email address and/or by the website that used the unique email address (*col.3 lines 15-20*

and 38-65, col.4 lines 35-43), which in turn allows the user to sort messages based on solicited or

unsolicited email according to the which unique email address is being used. Applicant's

arguments are therefore unpersuasive and the rejections over the prior art of record are

maintained.

Withdrawn - 35 USC § 112

II.   __Regarding Claims 1, 5, 28, 45, 56:__ the corrective claim language is sufficient for
overcoming the 35 U.S.C. 112, first paragraph rejection. The 35 U.S.C. 112, first paragraph
rejection is therefore withdrawn.

Claim Rejections - 35 USC § 103

III.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

IV.   Claims 1-6, 15, 16, 20, 28, 29, 41, 45, 46, 56, 57, 59, 60, 62, 64-67 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Pennell et al* (US 6,874,023) in view of *Winbladh* (US 6,205,330).

        a.   **Per claim 1**, *Pennell et al* teach a method comprising:

- a user computer providing a first email address received from an email service provider for use to register a user of the user computer with a first web site (*col.1 lines 53-62*); and

- the user computer providing a second email address received from the email service provider, separate and distinct from the first email address, for use to register said user with a second web site (*col.1 lines 12-15 and 56-61, col.3 lines 24-34*).

Pennell et al teach an email management service that generates a new email address whenever needed or requested by the user (*col.3 lines 1-12 and 35-42, col.4 lines 15-17*), which implies that the new email address is separate and distinct from the email address currently used by the user. *Pennell et al* fail to explicitly teach wherein the first and second email addresses were provided to the user computer by the email service provider in advance of providing the first and second email addresses to the first and second web sites by the user computer. However, *Winbladh* teaches that upon successfully obtaining an email account, a user is sent correspondence including the registered email address and alias addresses for the registered user in advance of using the email and alias addresses (*col.4 lines 54-57, col.8 lines 46-50*).

        It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Pennell et al* with *Winbladh* for the purpose of generating first and second (multiple) email addresses to registered users, in order to provide the users with additional email addresses usable for communicating with particular websites or other

users from aliased identities which ensures the user's privacy and minimizes unsolicited email communications with the user.

b.   **Claims 28, 41, 45, 56, 59, 62 and 67** contain limitations that are substantially equivalent to claim 1 and are therefore rejected under the same basis.

c.   **Per claim 2,** *Pennell et al* with *Winbladh* teach the method of claim 1, *Winbladh* further teaches wherein the first email address comprises a first user identifier, and the second email address comprises a second user identifier, separate and distinct from said first user identifier (*col.4 lines 54-57, col.8 lines 46-50*).

d.   **Claim 4** is substantially similar to claim 2 and is therefore rejected under the same basis.

e.   **Per claim 3,** *Pennell et al* with *Winbladh* teach the method of claim 1, *Pennell et al* further teach wherein the first email address comprises an address of the email service provider, and the second email address comprises the address of the same email service provider (*col.3 lines 1-12 and 35-42; Winbladh: col.4 lines 54-57, col.8 lines 46-50*).

f.   **Per claim 5,** *Pennell et al* with *Winbladh* teach the method of claim 1, *Winbladh* further teaches wherein said providing of the first and second email addresses by the user computer comprises selecting by said first and second email address from a plurality of distinct email addresses simultaneously provided by said email service provider to said user computer (*col.4 lines 54-57, col.8 lines 46-50*).

g.   **Claim 29** is substantially similar to claim 5 and is therefore rejected under the same basis.

h.   **Per claim 6,** *Winbladh* teach the method of claim 5, wherein the method further comprises the user computer obtaining the distinct email addresses from the email service provider in advance of the selection (*col.4 lines 54-57, col.8 lines 46-50*).

i.   **Per claim 15,** *Pennell et al* with *Winbladh* teach the method of claim 1, *Pennell et al* further teach wherein the method further comprises: receiving emails addresses to said first and second email; organizing said received emails based at least in part on whether the emails are addressed to the first of the second email address (*col.4 lines 15-43*).

j.   **Per claim 16,** *Pennell et al* teach the method of claim 15, wherein said organizing of said received emails is at least further based on whether said received emails addressed to said first or second email address were sent respectively by said first or second web site or not (*Figure 6, col.3 lines 53-65, col.4 lines 35-43*).

k.   **Claims 64, 65, 69 and 70** are substantially similar to claims 15 and 16 and are therefore rejected under the same basis.

l.   **Per claim 20,** *Pennell et* with *Winbladh* teach the method of claim 1, *Pennell et al* further teach wherein the web site is a content provider, a service provider and an access provider (*col.1 lines 17-31*).

m.   **Per claim 46,** *Pennell et al* with *Winbladh* teach the apparatus of claim 45, *Winbladh* further teach wherein the programming instructions (when executed) enable the apparatus to provide a plurality of distinct email addresses to the electronic device used by the user in advance of the first and second email addresses' initial selection for usage, for the electronic device to select said first and second separate and distinct email addresses (*col.4 lines 54-57, col.8 lines 46-50*).

n.   **Claims 57 and 60** are substantially similar to claims 5 and 46 and are therefore rejected under the same basis.

o.   **Per claim 66,** *Pennell et al* with *Winbladh* teach the method of claim 62, *Winbladh* further teach the method further comprising: generating and sending a request to the email service provider to return a set of email addresses including a plurality of distinct email addresses (*col.4 lines 54-57, col.8 lines 46-50*).

p.   **Claim 71** is substantially similar to claim 66 and is therefore rejected under the same basis.

V.   Claims 13, 14, 24, 26, 27, 31, 32, 42-44, 48, 49, 58 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Pennell et al* (US 6,874,023) in view of *Winbladh* (US 6,205,330) in further view of *Beyda et al* (US 7,120,927).

q.   **Per claim 24,** *Pennell et al* teach a method comprising:

- an electronic device requesting and receiving for a user, a first email address from an email service provider at a first point in time subsequent to the user subscribing for email service with the email service provider (*col.1 lines 53-62*);

- the electronic device employing the received first email address to facilitate communication between the user and a first communication partner or group of communication partners (*col.1 lines 12-15 and 56-61, col.3 lines 24-34*);

- the electronic device requesting and receiving for the user, a second email address, separate and distinct from said first email address, from the email service provider at a second point in time subsequent to the user subscribing for email service with the email service provider, the second point in time being a later point in time than the first point in time (*col.1 lines 53-62, col.3 lines 1-12 and 35-42, col.4 lines 15-17—new email address needed by user is separate and distinct from user's current email address*); and

- the electronic device employing the received second email address to facilitate communication between the user and a second communication partner or group of communication partners (*col.3 lines 13-65*).

Winbladh teaches that upon successfully obtaining an email account, a user is sent

correspondence including the registered email address and alias addresses for the registered user

(*col.4 lines 54-57, col.8 lines 46-50*). Yet *Pennell et al* and *Winbladh* fail to explicitly teach the

electronic device, prior to the first communication partner or group of communication partners

initiating a communication with the user, notifying the email service provider of said

employment of the first email address to facilitate communication with the first communication

partner or group of communication partners and the electronic device, prior to the second

communication partner or group of communication partners initiating a communication with the

user, notifying the email service provider of said employment of the second email address to

facilitate communication with the second communication partner or group of communication

partners.

However, *Beyda et al* teach that a user notifies the relay server of the selected

alias email address prior to using the alias email address (*col.5 lines 19-45, col.7 lines 21-63*). It

would have been obvious to one of ordinary skill in the art at the time the invention was made to

combine the teachings of *Pennell et al* and *Winbladh* with *Beyda et al l* for the system to provide

means for notifying the email server of the use of the alias email address in order the server to

properly process, detect and filter messages addressed to all of the user aliases.

r.   **Claims 13, 14, 26, 27, 31, 32, 42-44, 48, 49, 58 and 61** are substantially similar

to claim 24 and are therefore rejected under the same basis.

**VI.   Claims 12, 17-19, 33-38, 50-55, 63 and 68-70 are rejected under 35 U.S.C. 103(a) as
being unpatentable over *Pennell et al* (US 6,874,023) in view of *Winbladh* (US 6,205,330) in
further view of *Gabber et al* (US 6,591,291).**

r.   **Per claim 33,** *Pennell et al* and *Winbladh* teach a method comprising: an email service provider receiving emails addressed to a first and second email address of a user, the first and second email addresses being separate and distinct from each other having been provided by the email service provider to an electronic device of the user for the electronic device to facilitate communication between the user and a first intended communication partner using the first email address and to facilitate communication between the user and a second intended communication partner using the second email address (*Pennell et al: col.3 lines 1-65; Winbladh: col.4 lines 54-57, col.8 lines 46-50*).

Pennell et al further teach the email server provider organizing the received emails based on the distinct email addresses of users and allowing for the user to designate which are wanted or unwanted (*Figure 6, col.3 lines 53-65, col.4 lines 35-43*); yet *Pennell et al* and *Winbladh* fail to explicitly teach the email server provider organizing said received emails based at least in part on said first and second email addresses of the user, and respective intended versus unintended communication partners of said first and second email addresses of the user. However *Gabber et al* teach organizing and filtering of reply emails based the alias source address, wherein the alias source address depends on the destination address in order to identify which alias addresses are reject alias source addresses—if the reply email contains a reject alias source address then the reply message is deleted (*Abstract, col.3 lines 20-44, col.8 lines 5-18 and 27-66*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Pennell et al* and *Winbladh* with *Gabber et al* for the purpose of organizing email messages according to the user's different email addresses and presenting the email messages of interest to the user, wherein the user can bypass reading

messages from parties of no interest. This also provides users an effective way to determine where junk email purveyors obtained the user's alias source address.

s.   **Claims 17, 35, 36, 50, 52, 53 and 69** contain limitations that are substantially equivalent to claim 33 are therefore rejected under the same basis.

t.   **Per claim 34,** *Pennell et al* and *Winbladh* with *Gabber et al* teach the method of claim 33, *Pennell et al* wherein said organizing of said received emails is at least further based on whether said received emails addressed to said first or second email address were sent respectively by said first or second web site or not (*Figure 6, col.3 lines 53-65, col.4 lines 35-43; Gabber et al: col.8 lines 56-66*).

u.   **Claim 51 and 70** are substantially equivalent to claim 34 and are therefore rejected under the same basis.

v.   **Per claim 37,** *Pennell et al* and *Winbladh* with *Gabber et al* teach the method of claim 36, *Gabber et al* further teach wherein said deletion is performed in response to user instruction (*col.8 lines 35-37*).

w.   **Claims 18 and 54** are substantially similar to claim 37 and are therefore rejected under the same basis.

x.   **Per claim 38,** *Gabber et al* teach the method of claim 37, wherein the method further comprises providing the user with an end user interface feature to provide said deletion instruction with a single press of a key or control button (*col.3 lines 26-34, col.8 lines 56-66*).

y.   **Claims 19 and 55** are substantially similar to claim 38 and are therefore rejected under the same basis.

z.   **Per claim 63,** *Pennell et al* and *Winbladh* with *Gabber et al* teach the method of claim 62, *Gabber et al* further teach the method further comprising: sending information to the email service provider relating the first email address to the first intended communication partner or partners and the second email address to the second intended communication partner or partners (*col.3 lines 35-41, col.8 lines 27-50*).

aa.   **Claims 12 and 68** are substantially similar to claim 63 and are therefore rejected under the same basis.

Conclusion

VII.   THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

VIII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie D. Shingles whose telephone number is (571)272-3888. The examiner can normally be reached on Monday 8:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
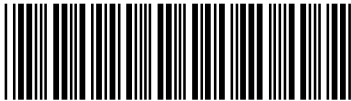
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie D. Shingles
Examiner
Art Unit 2141

kds

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2144

Application Number	Application/Control No.	Applicant(s)/Patent under Reexamination
	09/504,236	PORTER, SWAIN W.
	Examiner	**Art Unit**
	KRISTIE D. SHINGLES	2141